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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/338,729	06/23/1999	DENNIS GROSS	10853/1	1761

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/338,729

Applicant(s)

GROSS, DENNIS

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-15, 28-, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 76-78, 85, 88, 90-117 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 11-15, 28-, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 76-78, 85, 88, 90-117.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 17, 2004 has been entered. Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 76-78, 85, 88, 90-117 are pending.

Claim Objections

Claim 44 is objected to because of the following informalities: typographical error in reciting "messaging" in lines 4 and 10. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The broadest claim in the present application is Claim 117, which is directed to a method of treating skin, comprising the sequential step of a) applying to the skin a first liquid composition of pH of 2.5-4 which comprises an acidic agent; b) neutralizing the composition by applying to the skin a second composition of pH 7-12, which comprises at least one surfactant/emulsifier and an alkaline agent; and c) applying to the skin a

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moisturizer, sun screen and/or makeup without proceeded by rinsing off the first and second compositions from the skin.

Another independent claim, Claim 90, is directed to the similar method but requires 0.1-10 % of the surfactant/emulsifier in the second composition, and also requires the second composition to dry on the skin before applying to the skin the moisturizer, sunscreen and/or makeup when the first and second compositions remain on the skin.

In Claim 40, the invention is directed to yet another similar method, but requires specific ingredients and the amounts in the first and second compositions. Claim 44 also differs from Claims 117 and 90 in that the method is for treating the skin of a consumer and method consists essentially of the sequential steps of a) applying to the skin first composition by massaging into the skin with a pad saturated with the composition; b) allowing the composition to dry on the skin; c) neutralizing the first composition by applying the second composition by massaging into the skin with a pad saturated with the composition; d) allowing the composition to dry on the skin; and e) applying a moisturizer, sunscreen and/or makeup to the skin when the first and second compositions remain on the skin.

Claim 44 is directed to a method *consisting essentially of* the same method steps as recited in Claim 40. It is respectfully pointed out that the purpose of searching for and applying prior art under 35 U.S.C. §§ 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually, "consisting essentially of" will be construed as equivalent to comprising. If an applicant contends

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that additional steps in the prior art are excluded by the recitation of “consisting essentially of”, applicant has the burden of showing that the introduction of additional steps would materially change the characteristics of applicant’s invention. See MPEP § 2111.03.

1. Claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 77-78, 85, 88, 90-99, 101-106, and 109-117 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis (US 5720949) in view of Rapaport (US 5505948).

Davis teaches a skin peel cosmetic mask which is applied to the skin, particularly the face of a consumer. See col. 1, lines 35 –49. The prior art teaches that the notion of treating the skin by the heat and foam that are generated by sequentially applying an effervescent agent and acid components is well known. The reference teaches that these compositions are applied in any convenient order, and particularly teaches that the acid composition is applied first if an enhanced exfoliation of the skin is desired or in the absence of pretreatment with alpha- or beta-hydroxy acids. See col. 10, lines 43-51. See instant claim 47, 49, 50.

The reference teaches that one composition may be in the form of a cream mask, comprising i) 0-25 % of a nonliquid organic material of moderate melting point ii) 1-25 % of a surfactant system iii) 40-90 % of water; and iv) a thickening agent to provide a viscosity of 50,000 to 1million cps at 25 °C. The reference teaches using 1-20 % of an effervescent agent, particularly sodium bicarbonate. See col. 7, lines 32 – 43. The cream mask composition is said to have a pH range of 7.5-9, and contains 0.05-0.1% of essential oils and astringents, particularly witch-hazel. See col. 7, lines 57 – col. 8, line

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13. Using sodium hydroxide is also taught in col. 12, lines 15 – 26. Surfactants such as cetareths, ceteths, laneths, nonoxynols, octoxynols, glyceryl stearate, PEG-castor oil, poloxamers, poloxamines, and steareths are taught at col. 5, line 47- col. 6, line 35.

See instant claims 11-15, 101-103, and 116.

The other composition is in the form of gel, ("the Gel Activator"), and provides a carrier for the acid component. The composition contains i) 55-90 % of an organic solvent; ii) a thickening agent to provide a viscosity of 25,000 – 500,000 cps at 25 C; iii) 0-20 % of water; and iv) a buffering agent to provide pH of 3.5-6. See col. 8, lines 50-64. Using lactic, glycolic, and salicylic acids is taught, wherein salicylic acid and lactic acids are "especially preferred". See col. 8, lines 65 – col. 9, line 13. Malic and citric acids are also taught. See *Id.* The reference cautions of skin irritation by the acids, and teaches using 1-30 %, preferably 5-15 % of the acids by weight of the composition. See instant claims 28, 29, 36, 43, 85, 91-93, and 115.

While Davis teaches that the effervescent composition is in the form of "cream mask", examiner views that the "liquid" limitation of the instant claim is an obvious variation of the prior art. Davis teaches that lotion or tonic products, which are less viscous than cream mask, are applied to the skin of consumer by massaging these products into the skin. See col. 1, lines 27 – 32. Whether the composition is in the form of mask or liquid, these conventional forms are merely viewed as different means of delivery of active ingredients into the skin so that the reaction of the effervescent agent and acid component can take place thereon, which can be substituted by one for the other. See also Example 4, which teaches that sodium bicarbonate is contained in the

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gel accelerator and the lactic acid is in the cream composition. The motivation to make less viscous compositions to shorten the reaction time is also found in col. 11, lines 37 – 40, which teaches that viscosity of the compositions delays the time for complete reaction.

Davis teaches that first composition can remain on the skin for up to 10 minutes, and the combination of the first and second compositions can be maintained in contact on the skin for up to about 30 minutes. See col. 10, lines 52 – 65; col. 11, line 66 – col. 12, line 5. Thus, the compositions are given time to dry once they are applied to the skin. See instant claims 47, 49, 50, 70, 72, 73, 90, 111, and 112.

The claimed inventions in instant claims 117, 90, and 44 also requires that the first and second compositions not be “rinsed” or remain on the skin. While Davis teaches, “the residue is removed by means of a cloth or scraper. The face of the consumer may then be washed with a gentle soap composition.” See col. 12, lines 2-5. Although Example 1 shows washing the composition off the skin with a soap composition, Examiner views that “rinsing” is an optional method step in the prior art since the reference teaches that it *may* be washed. Furthermore, the description of the invention in col. 1, lines 46-48 merely indicates that the residue is removed from the skin of the user by means or scraper or cloth without further mentioning rinsing the skin. Nonetheless, Davis clearly teaches that massaging lotion or cream compositions into the skin does not require removing the composition. See col. 1, lines 26 – 32.

While Davis teaches surfactants and conventional cosmetic additives for the compositions, the reference fails to teach resorcinol in the acidic composition, as

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required in instant claims 40, 44, 77, 78, 104, 107, and 108. For Claims 40, 44, 46, 105, and 106, a composition comprising at least 0.1 % of sodium bicarbonate and 0.1 % of surfactant/emulsifier in 100 % balance of water meets the limitation of the second composition. Davis also lacks the method step of applying moisturizer, sunscreen or makeup composition after the treatment. Using a pad to apply the compositions is not explicitly mentioned.

Rapaport teaches home skin peeling/exfoliating compositions which comprises disodium EDTA, sodium benzoate, witch hazel, polysorbate (surfactant), salicylic acid, lactic acid, glycolic acid, resorcinol, dissolved ammonia, acetone, Germall 115 (imidazolidinyl urea, a preservative), alcohol, and water within the claimed amount. See instant claims 40, 44, 77, 78, 94-99, 104, 107, and 108. The reference further teaches that applying moisturizer and sunscreen to the skin after an acid peel to protect the skin is well known in the art. See col. 13, lines 34-56. The reference also teaches using applicator pad or pre-saturated pad of various constructions to apply the peeling/exfoliating compositions to achieve an abrasive effect for scraping, removing and cleansing action. See col. 10, lines 18-67. See instant claims 33-35, 109-110.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the skin treatment method of Davis by substituting the Rapaport acid peel/exfoliation composition for the acidic composition, as motivated by Rapaport, because 1) Davis teaches that it may be desirable to maintain an acidic composition on the skin for a gentle peel; 2) and the skilled artisan would have had a

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reasonable expectation of successfully achieving a gentle acid-peeling effects while the composition remains on the skin, as taught by Rapaport.

2. Claims 76, 100, 107, and 108 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis and Rapaport as applied to claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 77-78, 85, 88, 90-99, 101-106, and 109-117, and further in view of Linn et al. (US 4797273), Hahn et al. (US 5804203), and McAtee et al. (US 5811111).

Davis further teaches providing a skin conditioning regiment by applying a product rich of moisturizers, emollients, and humectants before the treatment. See col. 10, lines 1 – 30. The reference teaches to incorporate into the cream composition skin conditioning agents, preservatives such as methyl paraben, imidazolidinyl urea, antioxidants such as sodium ascorbate, tocopherol acetate, and trisodium EDTA. See col. 8, lines 14 – 49. Since the reference teaches here that salicylic acid, although not used in the composition comprising the effervescent agent, is an anti-acne agent it would have been obvious to a skilled artisan to use other suitable anti-acne agent. See col. 8, lines 14 – 35. While Davis teaches octoxynol, the combined references fail to teach octoxynol-9. Dimethicone copolyol, green tea extract, phospholipids, vitamin A, ascorbyl palmitate, phenoxyethanol, diazolidinyl urea, and tetrasodium EDTA are not specifically mentioned in the reference.

Linn et al. teach skin moisturizing microemulsions. Octoxynol-9 is taught as a cosmetically acceptable surfactant. See col. 6, lines 14-33.

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Hahn et al. teach that it is well known in cosmetic art to use green tea extract as an anti-irritant, Phospholipid PTC as a surfactant/moisturizer, Germaben II (diazolidinyl urea) as a preservative, ascorbyl palmitate as an antioxidant, vitamin A as an anti-acne agent, and dimethicone copolyol as a silicone carrier to produce a clear gel. See col. 4, lines 11-12; col. 19, lines 8-56. See Examples 3 & 6 for the amounts.

McAtee et al. teach that phenoxyethanol is among the most preferred antimicrobial used in a topical composition. See col. 10, lines 7 – 12. A leave-on formulation comprising tetrasodium EDTA is taught in Example 1.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modified the composition of the combined references by adding octoxynol-9 as the surfactant in the alkaline composition because 1) Davis teaches octoxynol; 2) it is known within the skill in the art to substitute one know species of surfactant for another; and 3) the skilled artisan would have had a reasonable expectation of successfully achieving similar surfactant effects that are cosmetically acceptable. The Hahn reference also would have motivated the skilled artisan to further incorporate the well-known cosmetic additives such as green tea extract, phospholipid, diazolidinyl urea, ascorbyl palmitate, vitamin A, and dimethicone copolyol because of the expectation of successfully producing a cosmetic composition with the desired cosmetic effects as taught. The skilled artisan would have been also motivated to use phenoxyethanol and tetrasodium EDTA as motivated by McAtee because of the expectation of successfully achieving antimicrobial and chelating effects, respectively, that are cosmetically suitable.

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Response to Arguments

Applicant's arguments with respect to claims 11-15, 28, 29, 33-36, 40, 43, 44, 47, 49, 50, 70-73, 76-78, 85, 88, 90-117 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-0635.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu
Patent Examiner


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